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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HAQ, NAEEM U	
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			3625	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,824

Applicant(s)

KINJO, NAOTO

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 22-38 and 40-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-21 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's amendment filed May 18, 2006. Claims 1-44 are pending. Claims 1-7, 22-38, and 40-44 were withdrawn in a previous Office Action and remain withdrawn. Claims 8-21 and 39 will be considered for examination.

Applicant's amendments are sufficient to overcome the rejection of claims 8-21 and 39 under 35 U.S.C. 112, second paragraph presented in the previous Office Action. This rejection is withdrawn.

Allowable Subject Matter

Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: Claim 12 recites that the order data is transmitted in advance as reservation information and that the selected time of an image displayed is based on the reservation information reserved by a customer. The prior art does not teach or suggest this limitation.

Specification

The amendment filed May 18, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claims 11 and 21 recite the limitation "real time". There is no support for this limitation in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite the limitation "real time". There is no written description support for this limitation in the Applicant's specification.

Art Unit: 3625

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims recite the limitation "real time". The term "real time" is a relative term which renders the claim indefinite. The term "real time" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8, 10, 11, 13, 15, 16, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Fredlund et al. (US 5,666,215) hereafter referred to as Fredlund.

Referring to claim 8: Fredlund teaches an ordering system comprising: a first information apparatus having an image displaying unit (col. 2, lines 34-37: "The customer is able to display the images(s) on his or her personal computer monitor or interactive TV along with an index number associated with each image"). The Applicant's specification discloses that the

Art Unit: 3625

first information apparatus is a television (paragraph [0138]). Fredlund also teaches a second information apparatus capable of transmitting order data at optional timing desired by a customer to said first information apparatus with respect to an image displayed on said image displaying unit of said first information apparatus (col. 5, lines 38-49: "The customer then identifies one of the images using a standard drag and drop computer interface or set-top box selection mode, for example by clicking on one of the images with a mouse or trackball and dragging it into the large display area 56, or by entering the desired frame number on a remote control device if the program is implemented via a set-top box. The customer can thereby use the computer data entry means to select one at a time the images he or she desires to have printed and desired services relating to each selected image. In this manner, a simple, non-intimidating display can be used to enter all necessary order information."). The Applicant's specification discloses that the second information apparatus can be a camera, PDA, cell phone, or remote control (paragraphs [0138] and [0141]). Finally, Fredlund teaches wherein said first information apparatus having received said order data adds predetermined data relating to said displayed image corresponding to said optional timing to said order data to prepare goods order data and transmits the goods order data to a third information apparatus in a predetermined destination of transmission (col. 4, line 46 – col. 5, line 16: "Responding to the instructions 29 and using appropriate identification, the customer through the personal computer 42 or set-top box/television combination is able to access the low resolution version of their digital image file contained in storage device 28. In the case of the computer, these images are then transferred over the communication channel to the personal computer 42 where the images are displayed on a display device such as a CRT 48 associated with the personal computer 42. The operator of the personal computer 42 is able to execute a suitable program...As Shown in FIG. 3, the program displays a graphical user interface 50 on the display device 48 that enables the customer to select the photographic services

Art Unit: 3625

desired.”; col. 6, lines 42-54: “When the order information for all the desired orders is complete[d] a payment interface screen 82 as shown in FIG. 5 is displayed. The payment interface screen 82 includes a scroll area 84 for indicating payment method, such as Master Card, or Visa. Spaces 86, 88 and 90 are provided for entering the payment card number, the card holders name and the card expiration date, respectively. A set of option buttons 92 are provided for indicating whether the order will be sent by modem or diskette. If the modem option is selected, a 1-800 phone number 94 for sending the order may be displayed, and after communication with the photo processing lab is established, the order can be sent by activating a “send” control button 95.”; Figure 3, item “76”). The Examiner notes that the limitations “...capable of transmitting order data for specifying an image displayed on said image displaying unit of said first information apparatus at a time selected by a customer to said first information apparatus...” and “wherein said second information apparatus prepares order indication information for specifically indicating contents of an order and including at least the number of goods relating to said specified displayed image and a method of receiving said goods...” are merely an intended use of the system of claim 8. A claimed invention should be distinguishable from the prior on the basis of structural elements rather than intended function. MPEP 2114 states the following:

“While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to

function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)... A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer"

Art Unit: 3625

The Examiner notes that the cited prior art reference discloses all the claimed structural elements as noted in claim 8. Therefore, as per MPEP 2114 guidelines, the cited prior art reads on the system of claim 8. Furthermore, the system of the prior art is capable of performing the intended functions of claim 8.

Referring to claim 10: Fredlund teaches all of the limitations of claim 8 as noted above. Furthermore, Fredlund teaches that the predetermined destination of transmission of said goods order data is set in said first information apparatus (col. 6, lines 42-54: "When the order information for all the desired orders is complete[d] a payment interface screen 82 as shown in FIG. 5 is displayed...A set of option buttons 92 are provided for indicating whether the order will be sent by modem or diskette. If the modem option is selected, a 1-800 phone number 94 for sending the order may be displayed, and after communication with the photo processing lab is established, the order can be sent by activating a "send" control button 95."; Figure 5, item "92").

Referring to claim 11: Fredlund teaches all of the limitations of claim 8 as noted above. Furthermore, Fredlund teaches that the order data is transmitted from said second information apparatus to said first information apparatus by the customer at said desired optional timing while watching said displayed image (col. 5, lines 32-49).

Referring to claim 13: Fredlund teaches all of the limitations of claim 8 as noted above. Furthermore, Fredlund teaches that the order data includes print order data for ordering a print of an image displayed on said image displaying unit of said first information apparatus at said optional timing (col. 5, lines 32-49); said predetermined data includes image data of an image displayed on said image displaying unit of said first information apparatus at said optional timing, processed image data thereof and information related thereto (Figure 3, item "76"; col. 5, lines 52-61); said goods order

Art Unit: 3625

data includes print order data for ordering a print of an image displayed on said image displaying unit of said first information apparatus (col. 5, lines 32-49); said first information apparatus transmits said print order data to said predetermined destination of transmission and said predetermined destination of transmission applies print processing to said print order data (col. 6, lines 42-54; col. 7, lines 18-30).

Referring to claim 15: Fredlund teaches all of the limitations of claim 8 as noted above. Furthermore, Fredlund teaches that the order data includes recording medium order data for ordering a recording medium in which data corresponding to an image displayed on said image displaying unit of said first information apparatus at said optional timing is recorded (Figure 3, item "76"; col. 5, lines 35-37: "To select one of the images from the digital image file, the customer selects the desired print size and quantity in area 76."), said predetermined data includes data corresponding to said displayed image at said optional timing and information related thereto (col. 5, lines 52-61), said goods order data includes recording medium order data for ordering a recording medium in which data corresponding to said displayed image is recorded (col. 5, lines 35-37), and said first information apparatus transmits said recording medium order data to said predetermined destination of transmission and said predetermined destination of transmission applies processing for recording said recording medium order data in said recording medium (col. 5, lines 35-37; col. 6, lines 50-54; col. 7, lines 18-27; col. 8, lines 56-63).

Referring to claim 16: Fredlund teaches all of the limitations of claim 15 as noted above. Furthermore, Fredlund teaches that the data corresponding to said displayed image includes processed image data thereof (col. 5, lines 52-61).

Referring to claim 19: Fredlund teaches all of the limitations of claim 13 as noted above. Furthermore, Fredlund teaches that the related information includes program data and is printed in association with said image data and said data corresponding to said displayed image and outputted to a computer readable recording medium in association with said image data or said data corresponding to said displayed image (col. 8, lines 20-24).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 14, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US 5,666,215) hereafter referred to as Fredlund.

Referring to claim 9: Fredlund teaches all of the limitations of claim 8 as noted above. Furthermore, Fredlund teaches that the predetermined data is goods characteristic information relating said displayed image (Figure 3, item "76"). Fredlund does not teach that the order data is orderer identification information, or that the information on said optional timing to be obtained by said first information apparatus is

Art Unit: 3625

time information in said second information apparatus accompanying said order data. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The elements of the recited system would be the same regardless of what information the order data or optional timing contained. The differences between the content of the Applicant's data and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the invention of Fredlund because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claim 14: Fredlund teaches all of the limitations of claim 13 as noted above. Fredlund does not teach that the print order data includes data recording instruction information. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the recited system would be the same regardless of what information the print order data contained. The differences between the content of the Applicant's data and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed

Art Unit: 3625

invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the print order data of Fredlund because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 17, 18, and 20: Fredlund teaches all of the limitations of claims 13 and 15 as noted above. Fredlund does not teach that the data corresponding to said displayed image is text data, or that the recording medium order data includes information on instruction for recording in said recording medium, or that the related information includes edition information. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The elements of the recited system would be the same regardless of the information used. The differences between the content of the Applicant's data and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any

Art Unit: 3625

information in the invention of Fredlund because such information does not functionally or structurally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US 5,666,215) hereafter referred to as Fredlund in view of Garland (US 6,366,359 B1).

Referring to claim 21: Fredlund teaches all of the limitations of claim 8 as noted above. Furthermore, Fredlund teaches that the first information apparatus is a television receiver and predetermined data relating to said displayed image at said optional timing includes image data of said displayed image of said television receiver (col. 2, lines 34-37: "The customer is able to display the images(s) on his or her personal computer monitor or interactive TV along with an index number associated with each image"). Fredlund does not teach that the image data of an image received by said television receiver and displayed thereon and original image data in a broadcasting station transmitting the image data to said television receiver are properly used as said image data of said displayed image of said television receiver. However, Garland teaches an integrated digital television and printer system that receives broadcast images and displays the images to a user who can then print a particular displayed image using a remote control device (col. 2, line 62 – col. 3, line 53). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Garland into the invention of Fredlund. One of ordinary skill in the art would have

been motivated to do so in order to print images displayed on a television as taught by Garland (col. 1, lines 12-23).

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US 5,666,215) hereafter referred to as Fredlund in view of Official Notice.

Referring to claim 39: Fredlund teaches all of the limitations of claim 8 as noted above. Furthermore, Fredlund teaches that the goods order data of the customer is temporarily accumulated (col. 8, lines 45-49). Fredlund does not teach that information for confirmation with order transmitting route information added to said goods order data is transmitted to said destination of communication of the customer for each order item based on orderer identification information. However, Official Notice is taken that it is old and well known in the art to send a confirmation notice of order to a particular individual based on an orderer's identification information. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of Fredlund. One of ordinary skill in the art would have been motivated to do so in order to notify a user that his or her order had been received.

Response to Arguments

Applicant's arguments with respect to the rejected claim have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3625

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naeem Haq, Primary Examiner
Art Unit 3625

August 7, 2006